



UNITED STATES DEPARTMENT OF COMMERCE
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BCL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/029,688 03/03/98 MADEMANN F P98.0162

LM12/0417
HILL STEADMAN & SIMPSON
85TH FLOOR SEARS TOWER
CHICAGO IL 60606

EXAMINER

SOBUTKA, P

ART UNIT	PAPER NUMBER
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2746

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DATE MAILED: 04/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/029,688

Applicant(s)

Mademann

Examiner

Phillip Sobutka

Group Art Unit

2746



☒ Responsive to communication(s) filed on Feb 8, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-13 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-4,6,10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Kauppi (US 5,953,667).

Consider claims 10,11,12. Kauppi teaches a location registration system in which mobiles transmit registration information that contains a cell identifier in addition to a location identifier (Kauppi see especially col 1, line 60 - col 2, line 48, col 4, lines 21-42), the cell identifier and location identifier being stored in a subscriber database of the MSC (Kauppi col 3, lines 33-48). Kauppi teaches that the cell identifier is used in the paging of the mobile to limit the signaling load by only paging in the identified cell (Kauppi see especially col 1, line 60 - col 2, line 48).

As to claim 13, note that Kauppi's method includes paging to adjacent cells (Kauppi col 4, line 40 - col 5, line 25).

As to claims 1-4,6, the system of Kauppi would perform the claimed steps.

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Claim Rejections - 35 USC § 103

3. Claims 5,7,8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kauppi in view of Tiedemann, Jr. et al (US 5,588,043).

As to claims 5,7,8, Kauppi lacks a teaching of storing the time of the last registration, along with the mobile, zone and cell identifiers. Tiedemann teaches storing the time of last registration in order to allow for the system to ensure minimum time between registrations (Tiedemann fig 1, item 50, col 1, line 54 - col 3, line 3, col 13, line 40 - col 14, line 65). It would have been obvious to one of ordinary skill in the art to modify Tiedemann to also store registration time in order to allow the system to use the timer method of registration as taught by Tiedemann in order to ensure minimum time between registrations.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kauppi.

Kauppi lacks a teaching of the identifiers being sent according to a packet data service. It would be appreciated by those skilled in the art that the above difference would depend more upon engineering design considerations than on any inventive concept limitation because the overall operation of the system would not be changed by naming any particular data transfer service. Official Notice is taken that packet data service is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art to modify Kauppi to use a packet data service to transfer the identifiers in order to utilize a resource efficient transfer method.

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Information Disclosure Statement

5. The information disclosure statement filed 3-3-98 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Response to Amendment

6. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

7. Also note that, while the IDS filed 2-8-00 was marked "sheet 1 of 2" only one sheet was present.

8. Note that the foreign language publication listed on the information disclosure statement need only have a translation or explanation submitted if the applicant wishes it to be considered.

Conclusion

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-6296, or (703) 308-6306,

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(for formal communications intended for entry)

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Sobutka whose telephone number is (703) 305-4825. The examiner can normally be reached on Monday-Thursday from 8:00 AM-5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Philip Sobutka

April 14, 2000

PJS:pjs

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700

